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Jurgen Bussert

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BAKER BOTTS L.L.P.

PATENT DEPARTMENT

98 SAN JACINTO BLVD., SUITE 1500

AUSTIN, TX 78701-4039

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JURGEN BUSSERT

Appeal 2008-4237
Application 10/056,905
Technology Center 2400

Decided:¹ April 29, 2009

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
STEPHEN C. SIU, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-16. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

INVENTION

The invention at issue on appeal relates to a method and a system for transferring partially encrypted control programs from a supplier to a customer. After editing, the partially encrypted control programs are decrypted at the customer site (Spec. 5, 18-19).

ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method for transferring control programs comprising

encrypting only a part of a control program code in a first development system,

transferring the encrypted control program code from the first development system to a second development system, and

decrypting the encrypted control program code in the second development system, wherein the decryption of the partially encrypted control program code is carried out following editing of the partially encrypted control program code in the second development system.

REFERENCES

The Examiner relies on the following references as evidence:

Redman	US 5,978,476	Nov. 2, 1999
Parlour	US 6,904,527 B1	June 07, 2005 (filed Mar. 14, 2000)

REJECTIONS

The Examiner makes the following rejections.

Claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Redman in view of Parlour.

II. ISSUES

Has the Examiner set forth a sufficient initial showing of obviousness of the claimed invention? The issue turns on whether Appellant has shown the Examiner erred by failing to identify a teaching of “editing of the partially encrypted control program code in the second development system” in the prior art, as recited in independent claim 1.

Has the Examiner set forth a sufficient initial showing of obviousness of the claimed invention in rejecting independent claim 8?

III. PRINCIPLES OF LAW

Prima Facie Case of Unpatentability

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In*

re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). Appellant has the opportunity on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Scope of Claim

The claim construction analysis begins with the words of the claim. See *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

IV. FINDINGS OF FACT

1. Redman discloses a computerized system that restricts access of certain circuit design files to a user (Abstract). Redman teaches an encryption process for encrypting the design encryption key 207 into a TagB and appending the TagB to the header 211 of the encrypted design file 103 (col. 6 ll. 21-28, Fig. 2). Redman also teaches a process of verifying correctness of the design decryption key 305 (col. 7. ll. 44-47). The verifying process includes the steps of recreating TagB using the design decryption key 305, comparing the recreated TagB with TagB stored in the header 211, and using the verified design decryption key 305 to decrypt the encrypted design file if the recreated TagB is identical to the stored TagB (col. 8. ll. 13-22).

2. Parlour discloses a method and a system to protect Intellectual property (IP) rights for securing configuration data used to configure a programmable logic device (PLD) (col. 3. ll.17-63).

3. Claims 8-14 contain limitations different from the limitations of claim 1 (see App. Br. Appendix A, pages 10-11). Claim 8 contains limitations directed to “an import[ing] device for importing the partially encrypted control program code and an editor for editing the control program which is connected between a decryption device for decrypting the partially encrypted control program code and the communication device.” Claim 8 only requires an editor is connected between decryption device and

the communication device. Claim 8, from which claims 9-14 depend, is reproduced below:

8. A system for transferring control programs, comprising a first development device for developing a control program code, said first device comprising an encryption unit for encrypting only a part of the control program code,, and a communication device for transferring the partially encrypted control program code from the first development device to a second development device, wherein said second development device comprises an import device for importing the partially encrypted control program code and an editor for editing the control program which is connected between a decryption device for decrypting the partially encrypted control program code and the communication device.

V. ANALYSIS

From our review of the Examiner's stated rejections, we find that the Examiner appears to have set forth a detailed explanation of initial showing of the prima facie case for obviousness. Therefore, we look to Appellant's Brief to show error in the Examiner's initial showing of obviousness.

With respect to independent claim 1, Appellant contends that Redman does not disclose "*editing of the partially encrypted control program code in the second development system*" (App. Br. 6). Appellant further contends that Parlour does not remedy this deficiency (App. Br. 6).

We agree with Appellants. We interpret broadly yet reasonably that "editing of the partially encrypted control program code" means performing any changes within the partially encrypted design file by the user. The

Examiner argued that “[t]he design processing engine performs the following steps: reconstructs the design decryption key, verifies correctness of the design decryption key by recreating TagB and confirms that the recreated TagB is identical to the TagB found in the header of the encrypted design file, decrypting the encrypted design file using the design decryption key [col. 7 line 55-col. 8 line 19]. Therefore, Redman teaches editing of the encrypted program as above.” (Ans. 8). However, we find that the Examiner’s reliance upon Redman to reject this express limitation of claim 1 to be not well founded since the portions of Redman relied upon by the Examiner only discuss the process of verifying design decryption key (FF1).

Furthermore, we find that utilizing a decryption key to recreate the TagB and then confirming the recreated TagB with TagB in the header of the encrypted file does not teach or fairly suggest the claimed “editing the partially encrypted design file” because the design decryption key and the recreated TagB are not parts of the encrypted design file. We find that nothing within the encrypted design file has been changed by the user in the verifying of the decryption key process let alone editing the encrypted design file. Thus, it is our reasoned conclusion that the Examiner erred in reading the process of verifying the decryption key in Redman as editing the encrypted design file. Finally, from the other cited portions of Redman and from our review of Redman, we find no express disclosure or fair suggestion for the argued limitation of independent claim 1.

We next look to the teachings of Parlour. The Examiner has merely relied upon Parlour for the limitation of concerning the partially encrypted file. The Examiner has not identified how the teachings of Parlour remedy the above noted deficiency (Ans. 8), and we find that Parlour does not disclose or fairly suggest editing the partially encrypted design file (FF2).

Hence, we find that the Examiner has not made a requisite showing of obviousness as required to teach or fairly suggest the invention as recited in claim 1 by the combination of teachings of Redman and Parlour.

Therefore, we agree with Appellant to the extent that the Examiner failed to clearly show that the combination of Redman and Parlour teaches or fairly suggests the argued feature attributed to the references; i.e., “editing of the partially encrypted control program code in the second development system.” The rejection of the dependent claims 2-7 and 15-16 contains the same deficiency. Appellant thus, has demonstrated error in the Examiner’s prima facie case for obviousness of the subject matter of claims 1-7 and 15-16.

With respect to claim 8, the one who bears the initial burden of presenting a prima facie case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Here, we find that the Examiner failed to meet this initial burden of presenting a prima-facie case of unpatentability of independent claim 8. Additionally, the Examiner has not identified how the combination of teachings of Redman and Parlour teaches or fairly suggests the invention as recited in claim 8 (FF3).

Appellant thus has demonstrated error in the Examiner's prima facie case for obviousness of the subject matter of independent claim 8. The rejection on the dependent claims 9-14 contains the same deficiency. Appellant thus has demonstrated error in the Examiner's prima facie case for obviousness of the subject matter of claims 9-14.

We, therefore, cannot sustain the rejection of claims 1-16 under 35 U.S.C. § 103 over Redman and Parlour.

VI. CONCLUSION

For the aforementioned reasons, we conclude that Appellant has shown the Examiner erred by failing to identify a teaching of "editing of the partially encrypted control program code in the second development system" in the prior art, as recited in claim 1.

We also conclude that the Examiner has not set forth a sufficient initial showing of obviousness for claim 8.

Appeal 2008-4237
Application 10/056,905

VII. ORDER

We reverse the obviousness rejections of claims 1-16.

REVERSED

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